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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,892	03/23/2001	Verivada Chandru Chandrasekaran	BSCO115540	7893

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EXAMINER

WILLSE, DAVID H

ART UNIT PAPER NUMBER

3738

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

Office Action Summary

Application No.

09/815,892

Applicant(s)

CHANDRESEKARAN ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-37 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 24-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other: _____

Claims 19-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

The Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claims and claim limitations (M.P.E.P. 714.02) and must do so in response to the present Office action.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "micro-pores, grooves, and cross-hatched lines" (claim 31, line 2) must be shown or the features canceled from the claim. No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 32, line 3, "is" should be --are--; on line 2, "minimizing" is deemed to render the claim indefinite as to the scope because a basis for comparison is not set forth (MPEP 2173.05(b); *Ex parte Anderson*, 21 USPQ2d 1241).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, 24, 28-31, 33, 34, 36, and 37 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Alt, US 6,099,561. Regarding claims 28-31: column 10, lines 23-26; Figure 2; etc. Regarding claims 33, 34, and 36, the materials (column 7, lines 44-49) for the structural member 11 provide a fraction (albeit a small one) of x-ray absorption (column 2, lines 48-50); alternatively, the core may be viewed as additionally comprising the layer 50 of noble metal.

Claims 25-27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alt, US 6,099,561. Regarding claims 25-27, the particular oxides, nitrides, and carbides are well known in the art and would have been obvious variants on the iridium oxide and titanium nitrate examples mentioned by Alt (column 10, line 1) in view of their similar purposes (column 10, lines 1-13) and in the absence of any criticality (in the Applicant's disclosure) for one material over the other. The further limitations of claim 32 would have been obvious, if not inherent, from column 4, lines 49-52; column 6, lines 4-6; etc.

Claims 17, 18, 24, 33, 34, 36, and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mayer, US 5,800,511.

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Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer, US 5,800,511. A platinum iridium alloy of approximately 70 percent platinum would have been obvious from column 10, lines 50-51, and from column 6, line 66, through column 7, line 7, in order, for example, to reduce costs somewhat, especially in the absence of any criticality (in the Applicant's disclosure) for this particular percentage.

Claims 17, 18, 24, and 33-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stinson, US 6,248,190 B1.

Claims 17, 18, 24, and 33-37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mayer, US 5,630,840: figures; column 11, lines 10-12; etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
January 14, 2003


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738